UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,531	11/27/2001	Tatsuji Nagaoka	9683/94	2033

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EXAMINER
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ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 November 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>27 November 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16,17, 19, and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Reynolds (US 6,799,327). As regards Claim 16, Reynolds discloses a

broadcasting system where a server (fig. 1.42) obtaining a program from a broadcast

station (fig. 1.32) distributes that program to a plurality of communication terminals (fig.

1.48) and where each communication terminal executes processing for the program,

wherein, the server distributes input prompting data prompting the user of the plurality of

communication terminals to input information required for progress of the program and

receives data transmitted from the communication terminals; each of the plurality of ·

communication terminals executes input prompting processing for prompting the user of

the communication terminal to input information based on the input prompting data (fig.

4C) and transmits to the server input data input in response to the input prompting

processing; and the broadcast station obtains from the server the plurality of input data

transmitted from the plurality of the input data (col. 5, lines 32-42).

As regards Claim 17, Reynolds discloses a server (fig. 1.42) obtaining a program

from a broadcast station (fig. 1.32) and distributing it to a plurality of communication

terminals (1.48), the server comprising: a storage unit for storing input prompting data

prompting the user of the plurality of communication terminals to input information

required for progress of the program (col. 4, lines 8-12); an input prompting data

distributing unit for distributing to the communication terminals the input prompting data

stored in the storage unit (fig. 1.38); an input data receiving unit for receiving input data

returned from the communication terminals in response to the input prompting data (col.

5, lines 40-42); and an input data transmitting unit for transmitting to the broadcast

station input data received by the receiving unit (fig. 1.40 and col. 3, lines 43-47).

As regards Claim 19, Reynolds discloses further comprising a communication

unit for establishing a communication link with the broadcast station (col. 3, lines 43-47

and) and receiving the program through the communication link and distributing to the

plurality of communication terminal the program received by the communication unit (fig.

1.46).

As regards Claim 20, Reynolds further discloses the storage unit stores a

plurality of the input prompting data for programs (such as advertisements) with different

contents for each time slot broadcast by the broadcast station, and the input prompting

data distributing unit distributes to the communication terminals the input prompting data

for the program being broadcast by the broadcast station among the input prompting

data stored in the storage unit (col. 4, lines 8-11).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (US

6,941,154) in view of Reynolds (US 6,799,327). As regards Claim 1, Ritter discloses a

method of provision of a program comprising: obtaining by a server a broadcast data of

a viewer participation program from a broadcast station (fig. 1.2); broadcasting by a

broadcast station the broadcast data (fig 1.7);and, generating by the server (fig. 1.6) a

mobile unit broadcast data from the broadcast data to distribute the mobile unit

broadcast data to distribute the mobile unit broadcast data to a plurality of

communication terminals (fig. 1.9) via a mobile communication network (fig. 1.8). He

does not disclose distributing by server an input prompting data for prompting a user of

the communication terminal to input information which is for progress of the viewer

participation program; displaying by the communication terminal on its display the

broadcast data and the input prompting data as an image; sending by the

communication terminal to the server an input data that is input in response to the input

prompting data; forwarding by the server that receives the input data these input data to

the broadcast station; updating by the server a part of the broadcast data which is to be

distributed to the plurality of the communication terminals based on the input data, and

updating by the broadcast station the part of the broadcast data to be broadcast based

on the input data. Reynolds does disclose distributing by server an input prompting

data for prompting a user of the communication terminal to input information which is for

progress of the viewer participation program (col. 8, lines 7-11); displaying by the

communication terminal on its display the broadcast data and the input prompting data

as an image (fig. 4C); sending by the communication terminal to the server an input

data that is input in response to the input prompting data; forwarding by the server that

receives the input data these input data to the broadcast station; updating by the server

a part of the broadcast data which is to be distributed to the plurality of the

communication terminals based on the input data, and updating by the broadcast

station the part of the broadcast data to be broadcast based on the input data (col. 7,

lines 65-67).

Ritter and Reynolds are analogous art because they both come from the same

field of endeavor, namely the field of interactive television.

At the time of invention, it would have been obvious to one ordinarily skilled in the

art to add the "pseudo ads" of Reynolds with the wireless transmission system of Ritter

to greater enhance the user's ability to interact with programming.

As regards Claim 2, Reynolds discloses a method of provision of a program of

Claim 1, wherein the broadcast data (such as an advertisement) is recorded before

broadcasting (fig. 1.35).

As regards Claim 3, Ritter discloses a method of provision of a program of claim

2, wherein the server (fig. 1.6) obtains a broadcast data broadcast from the broadcast

station (fig. 1.2).

As regards Claim 4, Reynolds discloses a method of a provision of a program of claim 2, wherein the server obtains a broadcast data from the broadcast station via a communication line connecting the server and the broadcast station (col. 3, lines 43-47).

As regards Claim 5, Reynolds discloses a method of provision of a program of Claim 2, the method further comprising, before the deliver of the input prompting data, delivering to the plurality of the communication terminal a participation prompting data for prompting the user of the plurality of the communication terminal to participate in the viewer participation program, prompting by the communication terminal the user of the communication terminal to participate in the viewer participation program based on the participation prompting data (fig. 4C), sending by the communication terminal to the server a participation request input by a user who is prompted to participate in the viewer participation program (col. 8, lines 7-11). Ritter discloses sending by the server the input prompting data only to the communication terminal that sent the participation request, when sending the input prompting data to the plurality of the communication terminal (col. 4, lines 18-23).

As regards Claim 6, Reynolds discloses a method of provision of a program of Claim 2, wherein, the broadcast station starts broadcasting the viewer participation program at a predetermined first time, and the server accepts receiving an input data before a second time that is after the first time, and does not accept receiving an input data after the second time (such as a lottery which always has a predetermined beginning and a predetermined end, when it is over) (fig. 4C).

As regards Claim 7, Reynolds discloses a method of provision of a program of claim 5, wherein, the broadcast station starts broadcasting the viewer participation program at a predetermined first time, and the server accepts receiving an input data before a second time that is after the first time, and does not accept receiving an input data after the second time (such as a lottery which always has a predetermined beginning and a predetermined end, when it is over) (fig. 4C).

As regards Claim 8, Reynolds discloses a method of provision of a program of claim 6, wherein, the viewer participation program broadcast station is an auction program, the input prompting data delivered b the server is a data for prompting the user of the plurality of the communication terminal to input a bid, and the input data sent by the plurality of the communication terminal to the server is a bid input by the user (col. 3, lines 16-17).

As regards Claim 9, Reynolds discloses a method of provision of a program of claim 7, wherein, the viewer participation program broadcast by the broadcast station is an auction program, the input prompting the data delivered by the server is a data for prompting the user of the plurality of the communication terminal to input a bid, and the input data sent by the plurality of the communication terminal to the server is a bid input by the user (col. 3, lines 16-17).

As regards Claim 18, Ritter discloses further comprising a program receiving unit for receiving the program broadcast from the broadcast station and distributing to the plurality of communication terminals the program received by the program receiving unit (fig. 1.6).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (US 6,941,154) in view of Reynolds (US 6,799,327) and Brown (US 5,794,219). As regards Claims 10 and 11, Ritter and Reynolds jointly disclose the method of provision of a program of Claims 8 and 9, but do not disclose that it further comprises, after the second time, extracting by the broadcast station a data having the highest bid from the bid sent from the plurality of the communication terminal, sending by the broadcast station to the server the data having the highest bid, and identifying by the server the user of the communication terminal that sent the highest bid based on the data having the highest bid sent from the broadcast station, and sending by the server to the communication terminal of this user a winning notification. Brown does disclose extracting by the broadcast station a data having the highest bid from the bid sent from the plurality of the communication terminal (fig. 10.141), sending by the broadcast station to the server the data having the highest bid, and identifying by the server the user of the communication terminal that sent the highest bid based on the data having the highest bid sent from the broadcast station, and sending by the server to the communication terminal of this user a winning notification (fig. 10.141).

Ritter, Reynolds and Brown are analogous art because they both come from the same field of endeavor, namely the field of electronic commerce.

At the time of invention, it would have been obvious to one ordinarily skilled in the art to add the auctioning system of Brown to that of Reynolds and Ritter so as to have a robust system to decide who is the winning bidder.

As regards Claim 12, Ritter discloses a method of provision of a program of claim 10, further comprising, after sending the winning notification, prompting by the communication terminal the user to select the method of paying for the product, sending by the communication terminal to the server the payment method data selected by the user, forwarding by the server to the broadcast station the payment method data, and settling by the broadcast station the payment of the product won by the user based on the payment method (col. 5, lines 61-65).

As regards Claim 13, Ritter discloses a method of provision of a program of Claim 11, further comprising, after sending the winning notification, prompting by the communication terminal the user to select the method paying for the product, sending by the communication terminal to the server the payment method data selected by the user, forwarding by the server to the broadcast station the payment method data, and settling by the broadcast station the payment method data (col. 5, lines 61-65).

As regards Claim 14, Ritter discloses a method of provision of a program of Claim 12, wherein the server comprises a data base storing information on users of the plurality of the communication terminal (col. 3, lines 54-58), and the server that receives the payment data from the communication terminal, based on the payment method data and the information on users stored in the data base, verifies if that user is the correct person, and, only when the user is verified to be the correct person, forwards to the server the payment method data (col. 6, lines 13-17).

As regards Claim 15, Ritter discloses a method of provision of a program of Claim 13, wherein the server comprises a data base storing information on users of the

plurality of the communication terminal (col. 3, lines 54-58), and the server that receives

the payment data from the communication terminal, based on the payment method data

and the information on users stored in the data base, verifies if that user is the correct

person, and, only when the user is verified to be the correct person, forwards to the

server the payment method data (col. 6, lines 13-17).

Conclusion

3.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David R. O'Steen whose telephone number is 571-272-

7931. The examiner can normally be reached on 8:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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